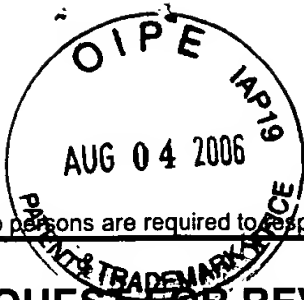


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PTO/SB/33 (07-05)

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## PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

UTSL:058US

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on August 2, 2006

Signature

Typed or printed name Mark T. Garrett

Application Number

09/707,435

Filed

November 6, 2000

First Named Inventor

Debra D. Wawro

Art Unit

2882

Examiner

Chih Cheng G. Kao

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

☒

attorney or agent of record.

Registration number 44,699

☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

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Telephone number

August 2, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

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\*Total of 3 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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## Arguments in Support of Pre-Appeal Brief Conference Request for 09/707,435

### I. The Obviousness Rejections of Independent Claims 1 and 38 and Their Rejected Dependent Claims over the Asserted Combinations Are Without Factual Support

Independent claim 1 recites at least one fiber having an end that has an endface, and a guided-mode resonance waveguide grating *fabricated* on the endface. Claim 38 recites providing such a fiber and *fabricating* such a guided-mode resonance waveguide grating on the endface of the waveguide. The Office takes the position that the asserted Cox-Peters combination satisfies these claims. However, Cox fails to disclose a fiber, and the only fiber that Peters discloses is *butt-coupled* to an array of VCSELs. None of the VCSELs are *fabricated* on the endface of the fiber.

Butt-coupling *is not* fabrication as the Office is claiming. Applicants explain this in section C of their June 1, 2006 response and in the Magnusson declaration filed with that response. The Office has submitted no evidence to the contrary. Accordingly, the rejections should be reversed. *See* MPEP § 2144.03 (“It is never appropriate to rely **solely** on common knowledge in the art without evidentiary support in the record as the principal evidence on which the rejection was based.”) (emphasis added) (citing *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001)).

In the “Response to Arguments” section on page 11 of the final Action, the Office states: “The combination of Cox et al. and Peters suggests a guided-mode resonance waveguide grating butt-coupled to the endface of at least one fiber as noted by Applicant. This combination makes obvious and reads on a guided-mode resonance waveguide grating fabricated (i.e., manufactured) on the endface of the at least one fiber.” These statements show that the Office is affirmatively asserting that butt-coupling *is* (“reads on”) fabrication. This assertion is not only factually unsupported, it is contradicted by the evidence of record (the Mangusson declaration).

Furthermore, even if it is appropriate to construe the “obvious” part of the Office’s statements as an assertion that butt-coupling *suggests* fabrication, that assertion should be rejected as unsupported by any evidence. *In re Zurko*, 258 F.3d at 1386 (With respect to **core factual findings** in a determination of patentability, however, the Board cannot simply reach conclusions based on its own understanding or experience – or on its assessment what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.) (emphasis added); *accord In re Lee*, 277 F.3d 1338, 1344-45 (Fed. Cir. 2002). Moreover, such an assertion is unsupported by any analysis. For example, there is no discussion of any of the *Graham* factors or why a motivation exists for shifting from butt-coupling to fabrication. The rejections should be reversed for these additional reasons.

The Magnusson patent used in the obviousness rejection of the claims that depend from 1 and 38 does not cure the deficiency described above. Accordingly, those rejections also should be reversed.

## **II. The Obviousness Rejection of Independent Claim 15 and Its Rejected Dependent Claims over the Asserted Combinations Are Without Factual Support**

Independent claim 15 recites at least one fiber having an end that has an endface, and a guided-mode resonance waveguide grating *fabricated* on the endface. It is patentable over the asserted Cox-Peters-Magnusson combination for the reasons given above.

The additional references of Tibuleac (§ 11 of Action), Morgan (§ 12 of Action), Lear (§ 13 of Action), and Magnusson et al. (“Guided-mode resonance Brewster filter”; § 19 of Action) used to reject the claims that depend from 15 fail to cure the deficiency described above. Accordingly, those rejections also should be reversed.